

Application Serial No. 10/620,749

Petition dated 18 January 2005 for Review of Objections by Examiner
Response to Office Action dated 18 November 2004

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REMARKS

The Examiner has stated that the specification is missing the following sections:

(e) BACKGROUND OF THE INVENTION

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under
37 CFR 1.97 and 1.98

(f) BRIEF SUMMARY OF THE INVENTION

Applicant respectfully submits that neither a BACKGROUND OF THE INVENTION nor a BRIEF SUMMARY OF THE INVENTION are required, and that the outline of sections suggested by the Examiner is a guideline illustrating a preferred layout, but which is not mandatory. Applicant respectfully submits that the specification does satisfy the mandatory and controlling requirements of 35 USC §112 and the Rules of Practice.

More particularly, Applicant respectfully requests overrule of the objection to the specification for the following reasons:

1. The Examiner has interpreted as mandatory, provisions of the rules that in fact are optional;
2. There is no requirement to provide a description of related art;
3. BACKGROUND OF THE INVENTION and BRIEF SUMMARY OF THE INVENTION sections are not required, and have never been required, in electronically filed patent applications; and
4. The undersigned has prosecuted a score of issued U.S. patents that do not incorporate either a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION; these sections were not considered mandatory in those U.S. patent applications by the many and varied examiners who issued them.

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1. The Examiner has interpreted as mandatory, provisions of the rules that in fact are optional

Applicant respectfully submits that the Examiner appears to have explicitly asserted that recitations of "should" in 37 CFR 1.77(b) are interpreted to mean "must". Applicant respectfully submits that the mandatory sections of the Rules of Practice already incorporate associated mandatory language such as "must" or "required", so that if Rule 37 CFR 1.77(b) was intended to be absolutely mandatory, then that rule would have been drafted with mandatory language. Instead, applicant respectfully submits that the word "should" in 37 CFR 1.77(b) is conditioned by 37 CFR § 1.77(c) which states as follows:

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type. (emphasis added)

Applicant respectfully submits Rule 37 CFR § 1.77(b) provides for the order of sections when those sections have been incorporated into the application, but does not otherwise mandate the incorporation into the application of a particular section enumerated in 37 CFR 1.77 §§ (b)(1) through (b)(11).

Whether or not a section of a patent application is required is governed by either Law or associated mandatory language of the Rules. The content of an application is governed by the laws of 35 USC §§ 111 and 112 which state, *inter alia*, as follows:

35 USC § 111(2): CONTENTS.—Such application shall include—

- (A) a specification as prescribed by section 112 of this title;
- (B) a drawing as prescribed by section 113 of this title; and
- (C) an oath by the applicant as prescribed by section 115 of this title.

(emphasis added)

35 USC § 112, first paragraph: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (emphasis added)

The law of 35 USC § 111 is implemented by Rules 37 CFR §§ 1.51 and 1.53, which state, *inter alia*, as follows:

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§ 1.51 General requisites of an application.

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

- (1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;
- (2) An oath or declaration, see §§ 1.63 and 1.68;
- (3) Drawings, when necessary, see §§ 1.81 to 1.85; and
- (4) The prescribed filing fee, see § 1.16. (emphasis added)

§ 1.53 Application number, filing date, and completion of application.

(b) Application filing requirements -Nonprovisional application. The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. ... (emphasis added)

Rule 37 CFR § 1.71 -- which applies to the detailed description and specification -- is mandatory under § 1.53(b) based upon 35 USC § 112; and the associated wording of § 1.71 uses corresponding mandatory language, as follows

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same. (emphasis added)

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth. (emphasis added)

Significantly, § 1.71 does not mention or require a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION.

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Similarly, 37 CFR § 1.75 -- which applies to the claims -- is also mandatory under § 1.53(b) based upon 35 USC § 112, and the associated wording of § 1.75 uses corresponding mandatory language ("must") where provided for by 35 USC § 112, as follows:

§ 1.75 Claim(s).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery. (emphasis added)

..

Rule 37 CFR § 1.72 -- which applies to the title and abstract -- is also mandatory, as follows:

§ 1.72 Title and abstract.

(a) The title of the invention may not exceed 500 characters in length and must be as short and specific as possible. ...

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." ... (emphasis added)

Rule 37 CFR § 1.73 provides the requirements of a Summary of the invention when such summary is set forth, as follows:

§ 1.73 Summary of the invention.

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Accordingly § 1.73 is not mandatory in respect of the inclusion of a BRIEF SUMMARY OF THE INVENTION, but provides the requirements thereof if a BRIEF SUMMARY OF THE INVENTION were to be provided. In the case of the instant application, because a separate BRIEF SUMMARY OF THE INVENTION has not been provided, then Applicant respectfully submits that § 1.73 would not apply to the instant application.

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Accordingly, the Examiner's present insistence upon the inclusion of a BACKGROUND OF THE INVENTION and a BRIEF SUMMARY OF THE INVENTION appears to be exclusively based upon Rule 37 CFR § 1.77, in which §1.77(b)(1) through b(11) provides for an arrangement of application elements. However, 37 CFR § 1.77(b) would appear to be governed by 37 CFR § 1.77(c), which states as follows:

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type. (emphasis added)

Accordingly, 37 CFR § 1.77 contemplates that some of the sections listed in paragraphs (b)(1) through (b)(11) thereof may not be applicable, which would mean that these sections might not otherwise be included in a particular patent application. For example, a "Cross-reference to related applications" ((b)(2)) would obviously not be necessary if there were no related applications, and a "Sequence Listing" (b)(11) would obviously not be necessary if the invention did not comprise a biological sequence. Drawings may also not be required (37 CFR § 1.74: "When there are drawings") The sections "Background of the invention" (b)(5) and "Brief summary of the invention" (b)(6) are not afforded a status that differs from any other section, and are not required by associated mandatory language in any other rule. Accordingly these sections would similarly also be optional. This interpretation is consistent with MPEP § 601 which states on page 600-3 (Rev. 2, May 2004) -- prior to the listing of the various possible section headings (A)-(K) -- as follows:

The following guidelines illustrate the preferred layout and content of patent applications filed under 35 U.S.C. 111(a). These guidelines are suggested for the applicant's use. See also 37 CFR 1.77 and MPEP 608.01(a). ... The following order of arrangement is preferable in framing the specification. See also MPEP 608.01(a). (emphasis added)

Accordingly, Applicant respectfully submits that 37 CFR § 1.77 as interpreted by MPEP § 601 provides guidelines that are suggested and may be preferred, but are not necessarily mandatory unless so stated by another Rule, e.g. as has been so stated for the **Title, Abstract, Detailed Description and at least one Claim.**

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Rules 37 CFR §§ 1.71 through 1.77 use mandatory language ("must" or "required") for mandatory provisions, and otherwise uses non-mandatory language ("may", "should") where the associate provisions are not mandatory, but instead are optional or conditional. Because there is no mandatory language actually used in the Rules in respect of a **BACKGROUND OF THE INVENTION** and a **BRIEF SUMMARY OF THE INVENTION**, Applicant respectfully submits that the Examiner should not, and may not, read mandatory language into 37 CFR § 1.77(b) with respect to a **BACKGROUND OF THE INVENTION** and a **BRIEF SUMMARY OF THE INVENTION** in the instant application. Applicant respectfully requests overrule of the Examiner's objection to the specification as presently drafted.

2. There is no requirement to provide a description of related art

The Examiner appears to have indicated that a **BACKGROUND OF THE INVENTION** must include "a description of related art including information disclosed under 37 CFR 1.97 and 1.98". Applicant respectfully submits that the Information Disclosure Statements submitted under 37 CFR §§ 1.97 and 1.98 are sufficient in and of themselves, and that there is no requirement for the Applicant to provide any further discussion of the prior art submitted therewith if such submissions are in the English language. MPEP §609 (page 600-129 of Rev. 2, May 2004) states that that "[t]he requirement for a concise explanation of relevance is limited to information not in the English language", a point that is also emphasized in a paragraph thereinabove. Accordingly, Applicant respectfully chooses to not provide a description of related art in any section of the patent application.

3. BACKGROUND OF THE INVENTION and BRIEF SUMMARY OF THE INVENTION sections are not required, and have never been required, in electronically filed patent applications in the USPTO

The only sections of a patent application indicated as being mandatory or required for electronically filed patent applications are the **Title**, **Detailed Description**, **Claims** and the **Abstract**. Included herewith in attached **Exhibits 1-3** are the copies of pages from the associated Help files for the heretofore three generations of electronic filing programs that have been used by the USPTO, as follows:

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In May 2001, the undersigned attended a USPTO Educational Workshops on Electronic Filing and the AIPA held in Troy, Michigan, and was advised by Mr. Robert Spar of the USPTO that headings can be deleted from files constructed using PASAT, so that one need not conform to what the USPTO considers to be a preferred organization of the specification.

4. The undersigned has prosecuted a score of issued U.S. patents that do not incorporate either a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION; these sections were not considered mandatory in those U.S. patent applications by the many and varied examiners who issued them

The following twenty-seven issued U.S. patents prosecuted by the undersigned do not contain either a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION:

6,317,048	6,378,900	6,392,542	6,407,660	6,420,997
6,424,319	6,433,688	6,445,294	6,470,272	6,529,811
6,552,662	6,583,616	6,586,926	6,587,048	6,606,077
6,609,055	6,631,776	6,644,688	6,678,095	6,703,845
6,777,927	6,825,765			

These patents were examined by various examiners supervised by various supervisory examiners in a variety of technology art units of the USPTO. Accordingly, given the issuance of these patents, they are powerful evidence that a U.S. patent need not include a BACKGROUND OF THE INVENTION or a BRIEF SUMMARY OF THE INVENTION. It would appear that the Examiner is in a very small minority in his view that these sections are mandatory in U.S. patent applications.

In view of the above remarks and submissions, Applicant respectfully requests overrule of the objection to the specification as presently drafted.

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Payment of Fees Under 37 CFR § 1.17 (h)

A credit card payment form is provided herewith in payment of the associated \$130 fee set forth in 37 CFR 1.17(h). The Commissioner is authorized to charge any deficiencies or credit any overpayments to the credit card indicated on the credit card payment form.

Summary and Conclusions

Applicant respectfully requests that the Examiner's objection to the specification for lacking a BACKGROUND OF THE INVENTION and a BRIEF SUMMARY OF THE INVENTION be overruled because these sections are not in fact mandatory under the Law and the Rules of Practice and because the USPTO has explicitly indicated that these sections are optional in electronically filed applications.

Respectfully Submitted,



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